

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. BALLONI,
JOSEF P. DEBBINS, KRISTINE L. GOULD,
ROBERT H. HAWORTH, AND THOMAS S. HLABAN

Appeal 2007-0430
Application 09/745,320
Technology Center 2100

Decided: July 3, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY,
and MAHSHID D. SAADAT, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-76. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). After considering the record, we are persuaded that "[t]he appeal is

manifestly not ready for a decision on the merits." *Ex parte Braeken*,
54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999).

II. PRINCIPLES OF LAW

In an *ex parte* appeal, the Board "is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*,
62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). "[T]o have meaningful
review, we must be able to understand the examiner's rejection. . . ." (*Id.*
1211-12. Furthermore, an "examiner's answer is required to include,"
M.P.E.P. § 1207.02 (8th ed., rev. 5, Aug. 2006), "[f]or each ground of
rejection maintained by the examiner and each new ground of rejection (if
any), an explanation of the ground of rejection." (*Id.*)

III. ANALYSIS

Here, the Examiner finally rejected "[c]laims 1, 17, 29, 64, 66 & 74,
as amended . . . under 35 U.S.C. 112, second paragraph, as being indefinite
for failing to particularly point out and distinctly claim the subject matter
which applicant regards as the invention." (Final Rej. 2.) Specifically, he
"f[ound] the wording 'substantially real time', (pending Claims 1, 17, 29, 64
& 74) . . . to be indefinite, requiring correction of the same." (*Id.*)

The Examiner's treatment of the indefiniteness rejection of claims 1, 17, 29, 64, 66 and 74 in his Examiner's Answer, however, is ambiguous. To wit, the *Grounds of Rejection to be Reviewed on Appeal* of the Answer includes a statement that "[t]he 35 U.S.C § 112, second paragraph rejections of claims 1, 17, 29, 64, 66 and 74 are withdrawn." (Answer 3.) In contrast, the *Grounds of Rejection* of the Answer begins with the sentence "[t]he following ground(s) of rejection are applicable to the appealed claims," (*id.*), and includes the following text.

Claims 1, 17, 29, 64 & 74, as amended, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Examiner finds the wording "substantially real time", (pending Claims 1, 17, 29, 64 & 74), to be indefinite, requiring correction of the same. For current examination purposes, said portions of the claim language will be ignored, and the claim(s) will be examined as though the indefinite portions were absent from the same.¹

(*Id.* 3-4) Furthermore, although the *Response to Argument* of the Answer includes a statement that "the 35 U.S.C. § 112, second paragraph rejections of claims 1, 17, 29, 64 and 74 are withdrawn," (*id.* 10), the *Response* also appears to explain the rejection. (*Id.* 9.)

¹ We caution the Examiner that ignoring claim limitations is contrary to the requirement that "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

IV. ORDER

"We decline to substitute speculation as to the rejection for the greater certainty [that] should come from the [Examiner] in a more definite [explanation] of the grounds of rejection[]." *Gambogi*, 62 USPQ2d at 1212. Instead, we remand the application to the Examiner to clarify his position in a Substitute Examiner's Answer. More specifically, a statement and explanation of each rejection "maintained by the [E]xaminer," M.P.E.P. § 1207.02, is needed in a *Grounds of the Rejection* of the Substitute Answer. **No withdrawn rejection, however, should be stated or explained therein. Nor should the *Response to Argument* of the Substitute Answer explain any withdrawn rejections.** A withdrawn rejection should only be listed in the *Grounds of Rejection Withdrawn*, (*id.*), of the Substitute Answer. Furthermore, the Substitute Answer should be self-contained with respect to all rejections and arguments; no prior Answer or Office action should be referenced or incorporated therein. Similarly, any additional Brief submitted by the Appellants should be self-contained with respect to all arguments. No prior Briefs should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

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REMANDED

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